



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,325	12/04/2001	Michael S.H. Chu	-06530.0285-00000.	9761

22852 7590 07/26/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

54

Office Action Summary	Application No.	Applicant(s)	
	10/000,325	CHU, MICHAEL S.H.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 and 61-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 and 61-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3731

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2005 has been entered.

Claims 1-4, 7-10, 14-19, 22-26, 30-34, 38, 39, 61-64, 67-70, 74-79, 82, 85-90, 94-98, 102-104 and 108-119 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al. (6,059,719). Yamamoto et al., in figures 16-17, for example, disclose elongate member (the combination of wires 137 and 22 which are secured together at 8a and 24 to form a single member) for insertion into a channel 20 of the endoscope 2, distal assembly 9c having an open configuration and a closed configuration with a profile larger than a diameter of the channel 20 of the endoscope 2. Alternatively, it would have been obvious that the combination of wires 137 and 22 form a single member since they are secured together at 8a and 24 to form a single entity. As to claim 3, Yamamoto et al. disclose a stop at 17b. As to claim 7, Yamamoto et al. disclose attachment

Art Unit: 3731

cup 7. As to claim 8, the activation shaft is inherently capable of rotating the distal assembly when the activation shaft is rotated. As to claim 9, the distal end of the activation shaft is bent when it is in a curved path in the body. As to claim 10, the distal assembly is inherently capable of obtaining and storing multiple small samples. As to claim 15, Yamamoto et al. disclose ring 24. As to claim 19, Yamamoto et al. disclose tube 7. As to claims 85 and 110, note figure 13, for example.

Claims 5, 6, 11-13, 27-29, 35-37, 65-66, 71-73, 91-93 and 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (6,059,719) in view of Townsend et al. (6,066,102). As to claims 5, 6, 27-29, 65, 66 and 91-93, Yamamoto et al. fail to disclose the details of the handle with the slide. However, it is old and well known in this art to so construct handles for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses casing (the frame on which handle 42 slides), slide 46, cap (at the proximal end of the frame), knob 44, 42 and a groove (the groove that 44 slides in). It would have been obvious to so construct the Yamamoto et al. handle so that it too would have this advantage. As to claims , 11-13, 35-37 and 71-73, Yamamoto et al. fail to disclose the details of the distal assembly and

Art Unit: 3731

elongate member. However, it is old and well known in this art to so construct a 1) distal assembly and 2) an elongate member in order to obtain the advantage of 1) performing specific operations and 2) for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses needle 718 and a lumen 28 to receive a medical device (col. 6, lines 44-55). It would have been obvious to so construct the Yamamoto et al. distal assembly and elongate member so that it too would have this advantage.

Claims 20, 21, 80, 81, 83, 84 and 105-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (6,059,719) in view of Lichtman (5,218,589). Yamamoto et al. fail to disclose a spring housed within the tube. However, Lichtman teaches that a spring (either of the spring leaves 62, 64) should be used to bias forceps jaws open which has the apparent advantage of insuring that the jaws open when desired. It would have been obvious to include spring leaves in the Yamamoto et al. device so that it too would have this advantage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

Art Unit: 3731

Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
7/22/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731